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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,251	01/31/2002	Bruce A. Jacobs	ABN0006-US	6565

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EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/059,251		JACOBS ET AL.	
	Examiner		Art Unit	
	Peter Poltorak		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,25,27-32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,25,27-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment, and remarks therein, received on 5/23/06 have been entered and carefully considered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

3. Applicant's arguments are directed towards newly introduced limitations and they are addressed in this Office Action.
4. Claims 23, 25, 27-32 and 34-39 have been examined.

Claim Objections

5. Claims 23, 25, 27-32 and 34-39 are objected to because of lack of consistency in the claim language. For example, claim 23 uses the article: "said" (e.g. "said first software", "said use value") and claims 27 and 31 uses the article "the" (e.g. "the software package user" and "the software package vendor").
6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
8. The term: "software package user" in claim 27 lacks antecedent basis. It is not clear whether the "software package user" should be treated as "said another software user", "said software package user", "a user" or something else. If the term should be treated as "said software package user"

Claim Rejections - 35 USC § 103

9. Claims 23, 25, 27-32 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Coley et al.* (U.S. Patent No. 5790664) in view of *Horstmann* (U.S. Patent No. 6009401).

Claim 23 does not require the steps of a method of coordinating the authorized use of a software package to be in a particular order. As a result, the examiner considers that the order of the steps is irrelevant and addresses the claim language accordingly.
10. As per claims 23, 25, 27, 37, 39 *Coley et al.* teach that a client module that utilizes the public network as a means to transparently send license inquiry request messages to, and receive license inquiry response messages from, a license server maintained by a software provider. The license server has a database on which license information, or records, are stored. The license server also can record information contained in license inquiry request messages, and thereby audit use of

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client applications. The license record can identify a license in accordance with a hardware address, or hardware identifier of the computer, such as an IP address. Furthermore *Coley et al.* teach that the client module automatically initiates a process to determine whether the software application is validly licensed. This can happen each time the client application is brought up (*Coley et al.*, col. 8 lines 1-5). This reads on “*detecting by a trusted third party when the software package user accesses the first software package*” and “*the detecting step comprises employing a monitoring agent*”.

11. *Coley et al.* discloses that a typical software license grants a permit to use the licensed software application on a particular machine (*col.1 lines 14-15*), if a license record is not found, the client application is not enabled (*col. 5 lines 23-24*) and if the query finds a valid license record the client module to enable or to allow continued operation of the software application (*col. 8 lines 17-25*).

This reads on: “*determining by said trusted third party whether the software package user has a valid software license to be authorized to use the first software package*” and “*permitting use of the first software package by the user if it is determined by the trusted third party that the user has a valid software license*”.

12. As per limitations “*respective usage costs for said first and said second software packages were previously negotiated and established with said software package vendor*” *Colley et al.* discloses software package availability offered by a vendor’s sale department (without the involvement of the trusted third party) (*via a telephone or a Web site, col. 8 lines 33-37*). Although *Colley et al.* stops short of addressing

negotiation process, establishing software packages terms prior to a purchase (e.g. costs, delivery terms, license terms etc.) would have been obvious to one of ordinary skill in the art of software package procurement at the time of applicant's invention given the benefit of deriving the most economical decision. Additionally, the examiner points out that evaluating different offers followed by a purchase reads on "the negotiation".

13. *Colley et al.* does not explicitly disclose: "*calculating a use value based at least on the number of current users of said first software package and said second software package and said respective usage costs for said first and said second software package and said second software package and said respective usage costs for said first and said second software packages*".

However, vendors frequently offer different software packages as well as different versions of the packages (e.g. Word Perfect Office 2000 or Microsoft Office, upgrade or regular software package, CompUSA Correl and Microsoft section) and corporate entities consider cost involved, especially since software packages offer different costs and capabilities. Also, the cost consideration of a software package such as Microsoft Office, inherently involves a number of users using the product.

Thus, it would have been obvious to one of ordinary skill in the art of software package procurement at the time of applicant's invention to calculate a use value based at least on the number of current users of said first software package and said second software package and said respective usage costs for said first and said second software package and said second software package and said respective

usage costs for said first and said second software packages prior to a purchase of software package given the benefit of deriving the most economical decision.

14. *Colley et al.* does not explicitly teach: “determining whether granting access to said second software package will cause said use value to exceed a predetermined maximum permissible use value”.

However, the purchase process inherently involves evaluating product costs verse available funds.

15. *Colley et al.* does not explicitly teach: “if granting access to said second software package will cause said use value to exceed said predetermined maximum permissible use value, offering to said another user, via said electronic network, an alternative software package to use that will, if accessed is granted, not cause a resulting use value to exceed said predetermined maximum permissible use value”,

However, *Colley et al.*, clearly discloses the purchase of software electronically via the Web (*Colley et al.*, col. 8 lines 35-37) and as disclosed by *CompUSA*, vendors frequently offer various alternative products (*software products over the phone or on their web sites, as illustrated by CompUSA*) and evaluating the alternatives e.g. regular package verse update that is less expensive would have been obvious, if not inherent, to one of ordinary skill in the art of software product procurement at the time of applicant's invention given the benefit of deriving the best business economic decision.

16. The above discussed process of said second software package purchase does not address: “receiving at said trusted third party an indication of an attempt by another

software user to access and use said second software package, said indication being received electronically over an electronic network connecting, directly or indirectly, said another software user with said trusted third party”.

However, *Colley et al.* discloses that users and the trusted third party communicating with each other over an electronic network (*col. 8 lines 60-67 Colley et al.*) and extending software monitoring to the second software package would simply have been implicit.

17. *Coley et al.* do not teach that a third trusted party is a bank involved in payments.

However, *Colley et al.* discloses that the license server can be maintained by a contracted service provider (*Colley et al., col. 7 lines 56-58*) and *Horstmann* teach a third trusted party (*Clearinghouse*) that is trusted by both software vendor and software user and that is involved in the software license compliance process (*Horstmann, Fig. 1 col. 4 lines 12-38*), and that is involved in the payment (*Horstmann, col. 1 lines 45-46*).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to involve a third trusted party in the software license compliance process and payment as taught by *Horstmann*. One of ordinary skill in the art would have been motivated to perform such a modification in order to alleviate a vendor from additional responsibility of protecting the product and to allow the vendor concentrating on software distribution.

18. As per claims 28-30, 35, 38 *Colley et al.* collecting and storing data related to software package usage, offering an alternative software package usage plan to the

software package user in the event the user does not have a valid software license (*Colley et al.*, col. 5 lines 23-29 and col. 8 lines 15-25), teach that the software packages operate on mobile communication devices (*Colley et al.*, col. 22 lines 5-27) and aggregating software package usage data from a plurality of software users (*Colley et al.*, col. 6 line 55 and col. 21 lines 9-16).

19. As per claim 31 *Colley et al.* and *Horstmann* do not explicitly teach offering a statement of usage to at least the software package user.

Official Notice is taken that it is old and well-known practice to offer a statement of usage to software package users (e.g. the software usage agreement to be accepted at the time of the software installation). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to offer a statement of usage to software package users in order to provide user's rights and obligation in regard to the purchased software.

20. As per claim 36 *Colley et al.* and *Horstmann* do not explicitly teach that the third party is at least one of a bank, an accounting firm and a university. However, *Horstmann et al.* suggests that the third party responsibilities can be performed by any entity. Employing a bank or accounting firm would have been an obvious choice to one of ordinary skill in the art at the time given the benefit that banks handle financial.

21. As per claim 34 *Colley et al.* and *Horstmann* do not explicitly reporting the software package usage data to the software package vendor.

However, in addition to reporting the software package usage data to the software package vendor being well known in the art and especially in light of *Colley et al.*'s disclosure of a billing system that translates an audit of a software use into billing statement (*col. 21 lines 9-16*) it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to report the software package usage data to the software package vendor given the benefit of providing relevant business strategy information to the vendor.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Frison et al. (U.S. Patent No. 6049789).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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